



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/579,821	05/17/2006	Yoshifumi Kobayashi	SATO 133NP	5947
23995	7590	09/18/2009	EXAMINER	
RABIN & Berdo, PC 1101 14TH STREET, NW SUITE 500 WASHINGTON, DC 20005			ROBINSON, GRETA LEE	
			ART UNIT	PAPER NUMBER
			2169	
			MAIL DATE	DELIVERY MODE
			09/18/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/579,821	KOBAYASHI, YOSHIFUMI	
	Examiner	Art Unit	
	Greta L. Robinson	2169	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>05/17/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-9 are pending in the present application.
2. A preliminary amendment was filed May 17, 2006. Claims 3 and 4 were amended; and new claims 8 and 9 were added.

Information Disclosure Statement

3. The information disclosure statement (IDS) submitted on May 17, 2006 has been considered by the examiner, note attached copy of form PTO-1449.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Independent claim 5 is directed to a *process*, however in order to be in compliance with 37 CFR 101 a process claim must (1) be tied to another statutory class (such as a particular apparatus) *or* (2) transform underlying subject matter (such as an article or materials) to a different sites or thing. If neither of these requirements are met by the claim, the method is not a patent eligible process under § 101 and should be

Art Unit: 2169

rejected as being directed to non-statutory subject matter. In the present case the claim does not positively tie the statutory class to a particular hardware element which would make the method steps tangible and does not transform the underlying data. MPEP § 2106.IV.B. *In re Bilski*.

The claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*.

Descriptive material can be characterized as either “functional descriptive material” or “nonfunctional descriptive material.” Both types of “descriptive material” are nonstatutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994)

Merely claiming nonfunctional descriptive material, i.e. abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because

“[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.”).

Regarding independent claims 1, 6 and 7 the specification provides evidence at page 4 and Figures 1-3, that the “apparatus”, “program” and “system” may be implemented as software. If elements would have been reasonably interpreted in light of the disclosure by one of ordinary skill as software alone, the claim is directed to software *per se* and is nonstatutory. Claims 2-4, 8 and 9 are rejected based on dependency.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 4, the following limitation is vague: “and/or” [see claim 4].

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 2169

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1 and 4-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Shoup et al. US Patent 6,108,657.

Regarding claim 1, Shoup et al. teaches a batch processing apparatus for creating desired output data based on arbitrary input data [see: abstract; and column 6 lines 54-64] comprising:

a metadata acquisition section for acquiring from a predetermined memorizing section, metadata defined as information concerning at least data item name, input, processing operation content, and output, as well as information previously stored in the memorizing section [note: Figure 5 (207) metadata storage unit; also see column 11 lines 49-58];

a data input section for inputting the input data based on a declaration process of the metadata acquired through the metadata acquisition section [see: Figure 5 (201) input control unit; also see column 9 lines 1-5];

a processing section for creating the output data by processing the input data input through the data input section, based on the declaration process of the metadata acquired through the metadata acquisition section [note: Figure 5 (209) control unit];

and

a data output section for outputting the output data created by the processing section, based on the declaration process of the metadata acquired through the

Art Unit: 2169

metadata acquisition section, wherein the processing section changes and creates all of the output data related to the metadata, according to change of the metadata [see: Figure 5 (206) display unit (i.e. output unit); and also note processing engines 209, 210, 211 and 212; column 6 lines 47-53].

10. Regarding 4: The batch processing apparatus according to claim 1, wherein the metadata express a process flow of the batch process, a content of intermediate data created in each process, and/or a link between the input data and the output data in each process [see: column 11 lines 49-58].

11. The limitations of independent claims 5, 6 and 7 parallel independent claim 1; therefore they are rejected under the same rationale.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Bosch et al. US Patent 5,787,412

Bowman-Amuah US Patent 6,640,244

Chang et al. US Patent 6,308,178

Mitchell et al. US Patent 5,497,491

Wolff US Patent 6,044,367

Witbrock et al. US Patent 6,581,057

Art Unit: 2169

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greta L. Robinson whose telephone number is (571)272-4118. The examiner can normally be reached on M-F 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tony Mahmoudi can be reached on (571)272-4078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Greta L. Robinson/
Primary Examiner, Art Unit 2169
September 17, 2009